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APPLICATION NUMBER	FILED DATE	FIRST NAMED APPLICANT	ATTY/DOCKET NO
08/950,542	10/16/97	BAUER/WHITEHORN	R 100-0472008

18M1 1224

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EXAMINER
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FUNCTION, D
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ART UNIT PAPER NUMBER

1801	18
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DATE MAILED: 12/24/97

This is a communication from the examiner in charge of your application  
COMMISSIONER OF PATENTS AND TRADEMARKS

### OFFICE ACTION SUMMARY

Responsive to communication(s) filed on 10/15/97

This action is FINAL.

Since this application is in condition for allowance except for formal matters, PROSECUTION AS TO THE MERITS IS CLOSED in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11, 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 12/15/97 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 13-14, 16-18, 21-34 is/are pending in the application.  
Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 Claim(s) \_\_\_\_\_ is/are allowed.  
 Claim(s) \_\_\_\_\_ is/are rejected.  
 Claim(s) 13-14, 16-18, 21-34 is/are objected to.  
 Claim(s) 13-14, 16-18, 21-34 are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948  
 The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.  
 The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved  
 The specification is objected to by the Examiner.  
 The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a) and  
 All  Some\*  None of the CERTIFIED copies of the priority documents have been  
 received  
 received in Application No. (Series Code Serial Number) \_\_\_\_\_  
 received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received \_\_\_\_\_

Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

1. *Notice of Allowance and Filing Fee Due Date*

2. *Notice of Informal Patent Application (PTO-152)*

3. *Use OFFICE ACTION OR THIS FORM IN A COPY*

Pursuant to the directive of paper No. 17, claim 13 has been amended, and claims 21-34 added. Claims 13-14, 16-18 and 21-34 are pending.

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Restriction to one of the following inventions is required under 35 U.S.C. §121:

- I. Claims 13-14, 16-18, 21-30, drawn to peptides bearing a boroProlyl moiety at the C-terminus, classified in e.g., 514/19.
- II. Claims 31-33, drawn to peptides bearing, at the C-terminus, one of a borate ester moiety, a fluoroalkyl ketone, or a phosphonate group, classified in e.g., 530/328.
- III. Claim 34, drawn to a method of inhibiting DP-IV, classified in e.g., 530/328.

The inventions are distinct. Groups I and II are distinguished because Group I neither requires or suggests fluoroalkyl ketones, or a phosphonate groups.

Inventions II and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP 806.05(h)). In the instant case the compounds of Group II can be used to inhibit

is a specific compound with all substituent variables fully accounted for.

Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a generic claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP 809.02(a).

Should applicant traverse on the ground that the species are not patentable distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. §103 of the other invention.

Applicant is reminded that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

A telephone call was made to Elizabeth Plumer on 12/19/97 to request an oral election to the above restriction requirement, but did not result in an election being made.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton whose telephone number is (703) 308-3213.

An inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



DAVID LUKTON  
PATENT EXAMINER  
GROUP 1800